

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant	: Ferman et al.	Group Art Unit	: 2623
Serial No.	: 09/823,377	Examiner	: Shang, Annan Q.
Filed	: March 30, 2001	Attorney Docket	: SLA 0346 (7146.0105)
Customer No.	: 55648		
Title	: AUDIOVISUAL INFORMATION MANAGEMENT SYSTEM		

REPLY BRIEF

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August 27, 2008

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
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Dear Sir:

BACKGROUND

This brief is in furtherance of the Notice of Appeal, filed in this case on February 4, 2008 and in response to the Examiner's Answer mailed on July 21, 2008.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION

There are 38 claims currently pending in the application.

B. STATUS OF ALL CLAIMS

Claims canceled: 1, 6-10, 39-42 and 49.

Claims withdrawn: None.

Claims pending: 2-5, 11-38 and 43-48.

Claims allowed: None.

Claims objected to: None.

Claims rejected: 2-5, 11-38 and 43-48.

C. CLAIMS ON APPEAL

Claims 2-5, 11-38 and 43-48 are on appeal.

A copy of the claims on appeal is set forth in the Claims Appendix to this Brief.

GROUND FOR REJECTION TO BE REVIEWED UPON APPEAL

The grounds of rejection presented for review are: (1) whether claims 24-27, and 45 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Labeeb et al, U.S. Pat. Pub. No. 2003/0093792 (hereinafter Labeeb); (2) whether claims 2-5, 11-15, 28-38, 43, 44, and 46-48 are unpatentable under 35 U.S.C. §103(a) over Maissel et al., U. S. Patent No. 6,637,029 (hereinafter Maissel) in view of Osawa et al., U.S. Patent No. 5,956,037 (hereinafter Osawa); (3) whether claims 16 and 19-23 are unpatentable under 35 U.S.C. §103(a) over Maissel in view of Osawa and in further view of Lee et al., U.S. Patent No. 7,127,735 (hereinafter Lee); and (4) whether claims 17 and 18 are unpatentable under 35 U.S.C. §103(a) over Maissel in view of Osawa and in further view of Lee, and in further view of Labeeb.

ARGUMENT

GROUP I (Claims 24-27 and 45)

The Examiner rejected claims 24-27, and 45 under 35 U.S.C. § 102(e) as being anticipated by Labeeb et al, U.S. Pat. Pub. No. 2003/0093792 (hereinafter Labeeb). The relevant limitations with respect to the claims of Group I are a usage history description scheme that contains “information about a user with respect to said at least one of said audio, image, and video *based upon previous usage of said at least one of said audio, image, and video*” and “said usage history description scheme including *data* indicating *whether* personal identification information of said user is intended to be revealed to third parties.” The applicant’s argument of record is that, although Labeeb indicates that (1) privacy is of concern to some viewers but not others and (2) that the disclosure of private information to advertisers is of value and can be obtained from some viewers by paying those viewers for the disclosure of private information, the limitation at issue is nonetheless not disclosed by Labeeb because that reference discloses that privacy decisions on the part of a viewer are implemented by hardware, i.e. where viewers wish to disclose private information, they get a special set top box; otherwise, the standard set top box has hardware that automatically prevents personal information from leaving the set top box. Thus, regardless of which set top box is being used, there is not only an absence of data in a usage history description scheme (as defined in the claim) indicating whether information is to be public or private, but such information would be of no use because it would not change the operation of the set top box, which is simply determined by hardware.

The Examiner does not appear to directly address these arguments. The Examiner notes that Labeeb discloses software that creates a demographic profile for a user. *See* Labeeb at par. 0234-35. This demographic profile, however, does not include any information indicating

whether its content is to be revealed. If a user has a set top box built to prevent advertisers from receiving personal information, set top box has a privacy filter that strips the demographic profile of personal information before it is transmitted from the set top box. No data in the usage history description scheme alters this behavior. Conversely, if a user has received remuneration in exchange for using a set top box that does not contain the privacy filter, personal information is not stripped from the demographic profile, and no information in the usage history description scheme is capable of changing this behavior, either. Thus, in no circumstances will the usage history description scheme include data indicating whether information from the demographic profile is to be shared. In fact, the Examiner acknowledges that in the system of Labeeb, “privacy is set at the manufacture and cannot be altered by software upgrade, tampering, etc.; non-concerned users purchase or receive a special [set top box] that enables return path sampling and other data to be collected.” *See Examiner’s Answer at p. 12.*

The Examiner’s response may be implying that the privacy filter is non-upgradeable firmware that includes data causing the user’s demographic profile to be stripped, i.e. the code that strips the data is what the Examiner considers the claimed “data” indicating whether data is to be revealed. There are two flaws with this reasoning. First, if a set top box has a privacy filter, that filter does not include data indicating *whether* data is to be revealed, it simply executes instructions on the *foregone conclusion* that personal information is *not* to be revealed. More fundamentally, the privacy filter is not a “usage history description scheme” that contains “information about a user with respect to said at least one of said audio, image, and video *based upon previous usage of said at least one of said audio, image, and video.*” The privacy filter, as conceded by the Examiner, is set at manufacture, hence cannot contain any information about any previous usage of a viewer.

Parenthetically, the applicant also notes that the Examiner failed to even allege the disclosure in Labeeb of the claimed “usage history description scheme”, instead arguing the disclosure of features not even recited in any of the claims of Group I, e.g. asserted “information about a user with respect to at least one of an audio, image, and video based upon interaction of the at least one type characterized by, at least in part, a time associated with the at least audio, image, and video and processes information to determine preferences of the user.” *See* Office Action dated November 2, 2007 at p. 4; *See also* Examiner’s Answer at pp 3-4. Nonetheless, not only does Labeeb likely disclose a “usage history description scheme” (*See* Labeeb at par. 0084, describing regression analysis of an individual user’s viewing habits to determine preferences, implying some record of a user’s viewing decisions from which preferences are derived) but the references cited with respect to the Examiner’s rejection of the claims of other Groups disclose a “usage preferences description scheme”, which could plausibly be combined with Labeeb. What is clear however, is that in each of the disclosures in the prior art of a “usage history description scheme”, Labeeb fails to disclose either the existence of data in that scheme indicating, whether personal information is to be revealed, or a reason for including such data in the prior art “usage history description scheme” for the reason previously discussed; including data in the claimed “usage history description scheme” would be either futile or redundant given that Labeeb discloses that privacy is “set at manufacture.”

Alternatively, the Examiner may believe that the possession of private viewing history data of a particular viewer by an advertiser indicates that it is to be revealed to third parties. In other words, the Examiner may be reading the claimed “usage history description scheme” on the data received by an advertiser from a set top box that lacked a privacy filter. *See* Examiner’s Answer at p. 12 (“Hence . . . the received usage data at ADMgr/Head end, from the EUE,

includes data indicating whether personal identification information of the user is intended to be revealed to third parties.”) Again, this reasoning has several flaws. First, it again ignores the claim term “whether” personal information is “to be” revealed to third parties, it indicates the truism that personal information “has been” revealed based on the lack of a privacy filter in the set top box, an easy distinction to realize. Moreover, the personal information collected from set top boxes without a privacy filter is statistically aggregated from thousands of viewers, meaning that the collected information, although in some sense personal, *is not “identification information”* as claimed, when it is received at the head end by advertisers/content providers. *See* Labeeb at par. 2926. This, of course is only sensible, as advertisers would find it extraordinarily inefficient to determine what advertisements would be particularly aimed at a single user; rather, the method of Labeeb aggregates personal demographic information from many thousand of users to establish general relationships between certain advertisements, for example, and specified demographic parameters, such as age group, marital status etc. The advertisers use this *aggregate* information to attach metadata to advertisements by which the *individual user’s set top boxes* can determine which advertisements to insert into programming. Thus, in the method of Labeeb, personal *identification* information is never “revealed to third parties” in the first instance, it is just collected from set top boxes to be automatically aggregated with information from other users prior to the collective information being revealed to third parties, at which point the aggregate information is no longer “identification” information.

Finally, the Examiner’s continued citation to the disclosure in Labeeb of pre-paid cards, insertable in a set top box, by which a user may exempt him or her self from being interrupted by advertisements when viewing programming content has no bearing on the claims at issue;

these prepaid cards contain no personal information whatsoever, which is one of the advantages cited by Labeeb.

For each of the foregoing reasons, the claims of Group I are patentably distinguished over Labeeb, and the applicant therefore respectfully requests that the rejection of these claims be withdrawn.

GROUP II (Claims 2-5, 34-38, and 48)

The Examiner rejected the claims of Group II under 35 U.S.C. § 103(a) as being obvious in view of the combination of Maissel et al., U. S. Patent No. 6,637,029 (hereinafter Maissel) in view of Osawa et al., U.S. Patent No. 5,956,037 (hereinafter Osawa). Independent claim 2, from which claims 3-5 depend, recites the limitation of “wherein . . . said user-description scheme *stored on said mobile storage device* includes an attribute *by which said user may* selectively prevent said electronic device from updating said usage preferences description scheme based on said usage history description scheme.” (emphasis added). For the first time, the Examiner alleges that this limitation is disclosed at col. 12 line 46 to col. 13 line 23 of Maissel. *See* Examiner’s Answer at p. 14. This disclosure in Maissel, however, refers to *firmware in the set top box* that operates once the profile from the mobile storage device is uploaded into the memory of the set top box. In other words, this disclosure of Maissel teaches a user interface resident on a set top box that allows a user to turn off collection of data by which a profile is updated. Maissel does not disclose any attribute of the preference scheme stored on the mobile storage device that prevents the set top box from updating that profile information; rather, Maissel discloses an attribute in the firmware of the set top box that performs this function.

Similarly, the Examiner's citation to Osawa to support the assertion that the prior art discloses the claimed "granularity attribute" of claims 34-38 and 48 is also inappropriate, as the features of Osawa to which the Examiner cites, i.e. the use of previous operation history to *playback* other video is not relevant to a granularity attribute by which *preference information* is *accumulated and stored* on the mobile storage device. For example, the disclosure that the content of one video can be played back in the same manner as another video (Maissel) is of no relevance to a technique of setting a granularity attribute that determines, for example, that preference information is only collected at the broad genre level, such as "horror" "comedy" etc. rather than a finer level of detail, e.g. "slasher", "vampire", "romantic comedy" etc. (claims 34-38 and 48). Moreover, the fact that the storage medium of Maissel does not accumulate or store programming content that is played back, should be dispositive of the issue. Maissel's storage device stores a preference profile; the recited features of Osawa relate to content stored, e.g. on a hard drive of a digital video recorder or a DVD. The two have nothing to do with one another.

For each of these reasons, the Examiner's rejection of the claims of Group II is improper, and the applicant respectfully requests that the rejection of these claims be overturned.

GROUP III (Claims 11-15 and 43)

The Examiner rejected the claims of Group III under 35 U.S.C. § 103(a) as being obvious in view of the combination of Maissel et al., U. S. Patent No. 6,637,029 (hereinafter Maissel) in view of Osawa et al., U.S. Patent No. 5,956,037 (hereinafter Osawa). Independent claim 11, from which claims 12-15 and 43 depend, recites the limitation of "said usage history description scheme used by said system to automatically periodically update a usage preference description of said user *on said mobile storage device, while said mobile storage device is inserted in said*

multimedia system.” The Examiner’s Answer asserts that “Maissel discloses where the usage history description scheme is used to *automatically, periodically* update a usage preference [scheme] of the user on the mobile storage device.” (emphasis added). This is not correct. Maissel discloses the *automated, periodic* update of the user profile stored in memory resident on the set top box. (See, e.g. FIG. 2 where the profile storage unit 140 is the memory of the set top box). The profile on the mobile storage device (element 160 of FIG. 2) is not rewritten to match that of the set top box except upon manual instruction by the user. *See* Maissel at col. 15 lines 11-17).

Therefore, the applicant respectfully requests that the Examiner’s rejection of the claims of Group III be overturned.

GROUP IV (Claims 16-23, and 44)

The Examiner rejected the claims of Group III under 35 U.S.C. § 103(a) as being obvious in view of the combination of Maissel, in view of Osawa, and in further view of Lee et al., U.S. Patent No. 7,127,735 (hereinafter Lee). The Examiner rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Maissel, Osawa, Lee and Labeeb.

Independent claim 16, from which claims 19-23 and 44 respectively depend, recites the limitation of a “usage history description scheme” that is stored on a mobile storage device and “is used by said audiovisual information management system to update a usage preference description scheme, and said usage history description scheme is not used by said audiovisual information management system to do any actions selected from the list of (i) selecting said at least one of an audio, an image, and a video; (ii) filtering said at least one of an audio, an image, and a video; and (iii) searching at least one of an audio, an image, and a video.” Stated simply,

the claims of Group IV require that the history profile stored on the mobile storage device be used, not to select programming content on behalf of a user, but instead to modify the preference profile on a set top box that does select programming content on behalf of the user.

The applicant's arguments of record are that the primary reference, Maissel teaches away from the recited limitation because that reference teaches that the information on Maissel's removable storage device is a usage preference description scheme that does the very things that the claims of Group IV renounce. The Examiner does not respond to this argument, instead merely repeating the assertion that Lee teaches a use for usage history not in the disclaimed list. However, the Examiner cannot plausibly contend that Lee teaches that the mobile storage device of Maissel no longer be used to select, filter, or search available programming content when that is the only purpose for the profile stored on the mobile device in the first instance.

Because Lee fails to teach modifying the system of Maissel such that it would no longer use the information on the removable storage to do any of the actions of "selecting said at least one of an audio, an image, and a video; (ii) filtering said at least one of an audio, an image, and a video; and (iii) searching at least one of an audio, an image, and a video", the Examiner's rejection is improper, and the applicant respectfully requests that the rejection of the claims of Group IV be reversed.

GROUP V (claims 28-33, 46, and 47)

The Examiner rejected the claims of Group V under 35 U.S.C. § 103(a) as being obvious in view of the combination of Maissel and Osawa. Independent claim 28, from which claims 29-33, 46, and 47 respectively depend, recites the limitation of "said system permitting a user to selectively define multiple levels of granularity by which the content of said usage history

description scheme is automatically accumulated, wherein the content of said usage history description scheme is used to update a usage preference description scheme.”

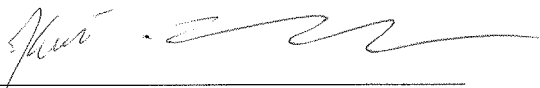
The Examiner argues that the secondary reference, Osawa, teaches various “VCR-like” functions by which a user may predefine the manner in which content is played back. For example, if an instructor repeatedly plays back the same video presentation for multiple classes, fast-forwarding or pausing certain portions, a system may record the manner in which segments are played back for the convenience of the instructor who then does not have to go through the same rote motions, repeatedly. This disclosure is irrelevant to the claims at hand. The claimed levels of granularity relate to the level at which usage history (used to update user preferences) is accumulated, not the level at which *individual programs* are browsed. Moreover, the Examiner’s rejection seems to be premised upon the assumption that Maissel’s mobile storage device, storing preference information, also stores the actual content that the preference information filters, etc. It does not. How a user elects to browse any given program has no bearing on the level of detail or granularity at which preference or history information, used to select later content, is stored.

Because the cited prior art fails to disclose the limitations of claims 28-33, 46, and 47, the applicant respectfully requests that the Examiner’s rejection of these claims be reversed.

CONCLUSION

The Examiner's respective rejections of claims 2, 3, 5-10, 12-79, 89-104, and 108-18 should be reversed, and the claims should be found patentable.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Kurt Rohlf", written in dark ink.

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